REMARKS

The office action of January 24, 2008 has been reviewed and these remarks are responsive thereto. Claims 2-4, 6-17, 20-30, 32-39, 42-46, 48-51, 53-56 and 60-73 are pending in the application. Reconsideration and allowance of the instant application are respectfully requested.

Rejections Under 35 U.S.C. § 112

Claims 2-4, 6-17, 20-30, 32-39, 42-46, 48-51, 53-56 and 60-73 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. Applicants respectfully traverse these rejections.

The Office Action states, "The disclosure fails to teach how one would know how to weight the nodes furthermore, how are they weighted with respect to the users interest as well as how it corresponds to the first node. One of ordinary skill in the art would not be able to make and/or use the invention as disclose[d] to obtain repeatable results." Page 2, lines 17-21. Applicants respectfully disagree.

The Specification as originally filed includes many examples illustrating ways how to weight nodes, how they could be weighted with respect to a user's interest and how they correspond to the first node. For instance, on page 19, line 25 through page 21, line 2, the Specification as originally filed states (see paragraphs 0083-0085 of the published application):

> [75] ... This information that is inferred about a user and that was obtained as a result of running the characteristic data through the inferencing engine is termed a *personalization interest graph (PIG)*. FIG. 6 illustrates the user's characteristics data 500 combined with the user's associated PIG results 501 in a user's profile 502. In an alternative explanation, the characteristic data may consist of *user source data* 504, *implicitly captured data* 505, such as click stream, and *explicit user data* 503. The PIG is inferred data.
>
> [0084] The PIG itself may be in the form of a tree, *simple list of corresponding ontology nodes* or DAG representing the user's inferred and non-inferred interests. ... The PIG is computed by inputting the characteristic data into the inferencing engine. The inferencing engine utilizes its rules base to apply the rules to the characteristic data applied against the ontology. ... The PIG can be considered as a subset of the ontology, but *different in that nodes also have associated weights indicating their importance to the user* (user's interest).

> [0085] Each node in the PIG contains a weighting indicating the degree to which the user is interested in the concept. Nodes in the computed PIG that have a larger weighting may be considered to be of greater interest to the user. The nodes in the ontology do not have weights associated with them. Nodes in the profile, however, are weighted. Characteristic data may be initially *be weighted by explicit user choice, or via algorithms*. For example, node weights may range from 1-10 points, where 1 indicates weak interest and 10 indicates strong interest. For the purposes of illustration, the weight range of 1-10 will be used and referenced throughout this invention. Characteristic data that is imported into the knowledge warehouse may be initialized with a medium interest level, for example. A domain expert may choose to weight different user data with various weights. Also, *users may explicitly make choices as to their interests* and thus affect how the weights are changed in the characteristic data. Once the characteristic data is weighted, it may be used as input to the inferencing engine to compute the PIG.

Emphasis added.

As noted in the above portion of the Specification, the personalization interest graph (PIG) can be a list of nodes (e.g., second nodes) corresponding to nodes (e.g., first nodes) of an ontology. The nodes of the PIG can be weighted in various ways including by explicit user choice and/or via algorithms, such as used by an inferencing engine.

Other portions of the Specification provide examples pertaining to weighting second nodes including example rules and algorithms for doing so. The following are portions of the Specification as originally filed providing relevant disclosure:

- Page 21, line 3 to page 22, line 2.
- Page 24, line 1 to page 29, line 3.
- Page 32, line 12 to page 38, line 15 (see also Figs. 16-19).
- Page 38, line 16 to page 43, line 6 (see also Figs. 20-23).

Applicants respectfully submit that Specification as originally filed provides many examples, disclosure and discussion describing the claimed invention in way that would enable a person of ordinary skill in the art to make and/or use the claimed invention including describing how the second nodes could be weighted with respect to a user's interests and how they correspond to the first node.

Further, Applicants respectfully submit that the pending claims and the claims as originally filed disclose how one could weight the second nodes with respect to the user's interest and how the second node can correspond to the first node. For instance, pending independent claim 62 recites, among other features, the subject matter of:

> a personalization interest graph for the user including a hierarchical collection of linked second nodes, the second nodes including the linked first nodes from the ontology, at least some of the second nodes being weighted nodes, the weighted second nodes including *weight values based on the user data and based on conclusions about the user made by the inferencing engine, each weighted second node corresponding to a first node of the ontology*, each weighted second node indicating the degree to which the user is interested in the concept of the corresponding first node of the ontology.

Emphasis added.

For at least the reasons discussed above, Applicants respectfully request reconsideration and withdrawal of these rejections.

Rejections Under 35 U.S.C. § 101

Claims 2-4, 6-17, 20-30, 32-39, 42-46, 48-51, 53-56, and 60-73 stand rejected under 35 U.S.C. § 101, because the claimed invention is allegedly directed to non-statutory subject matter. Applicants respectfully traverse these rejections.

On page 3, lines 3-11, the Office Action states,

> The claims fail to create a concrete result. The applicants claims are directed towards a "second weighted node indicating a user interest" that corresponds to the first node. The disclosure does not set forth steps on how one is to weight the nodes to indicate interest as well as how the interest corresponds to the first nodes. One skilled in the art would not be able to make the invention with repeatable results. The invention is such that two different users could interpret how to "weight a node" and what constitutes interest and how it corresponds to a first interest and obtain two completely different results based on their beliefs and thoughts as what is corresponding and what is of interest to the user.

Emphasis added.

The Office Action is unclear as to the basis for these rejections. The Office Action states, "The claims fail to create a concrete result," which implies the Patent Office takes the position that the claims are directed to a judicial exception of 35 U.S.C. §101 (i.e., an abstract idea, natural phenomenon or law of nature) and are not directed to a practical application of such judicial exception. Applicants respectfully submit that the claims are directed to a system, electronic process, computer system, and a computer-readable medium, which fall within accepted categories of patent eligible subject matter rather than a judicial exception.

In addition, the Office Action states, "One skilled in the art would not be able to make the invention with repeatable results" with respect to the subject matter of weighted second nodes, which implies the Patent Office takes the position that the claimed invention is not supported by a specific and substantial asserted utility.

Applicants respectfully submit that the claimed invention, including subject matter pertaining to weighted second nodes, has specific and substantial utility. As discussed above, the application as originally filed includes many examples of how one could weight the nodes to indicate a user interest and how the weighted second nodes correspond to the first nodes of an ontology, as well as describes specific and substantial utility provided therefrom.

The Office Action further asserts that two different users could interpret differently subject matter pertaining to how to weight a node, what constitutes interest, and how it corresponds to a first node and, thus, obtain two completely different results. Applicants agree that, as described in the Specification along with the examples therein and as noted above, the second nodes could be weighted in various ways based on a user's interest (e.g., explicit interest and/or inferred interest) and that what constitutes user interest could vary. The claimed subject matter is not necessarily limited to a single way of weighting nodes, identifying user interest, etc. The application as originally filed provided various examples and descriptions that could be used in various ways by one skilled in the art to make or use the claimed invention, which does not affect the statutory nature of the subject matter of the claims or their specific and substantial utility.

For at least these reasons, Applicants respectfully request reconsideration and withdrawal of these rejections.

Rejections Under 35 U.S.C. § 103

Claims 2-4, 6-17, 20-23, 25-31, 32-39, 42-46, 48-51, 53, 55-56, 60-67, and 68-73 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Pat. No. 6,151,584 to Papierniak et al. (Papierniak) in view of U.S. patent publication no. 2002/0010625 to Smith et al. (Smith). Claims 24, 51, and 54 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Papierniak and Smith, and further in view of Financialengines.com.

Smith does not constitute prior art to claims of the present application. Smith was filed on March 29, 2001, and subsequently issued as U.S. Patent No. 6,853,982. Based on its filing date of March 29, 2001, which is after the March 28, 2001, filing date of the present application, Smith is not prior art to the present application. The publication of Smith cited in the Office Action (2002/0010625) indicates that it is a continuation-in-part of U.S. patent application no. 09/156,237, which issued as U.S. Patent No. 6,317,722 to Jacobi et al (Jacobi). However, on its face, the Smith '982 patent does not maintain the priority claim of its publication. Further, Jacobi does not indicate a relationship to Smith nor does the PAIR system show a relationship between Smith and Jacob as of July 24, 2008. Accordingly, Applicants respectfully submit that Smith is not prior art to the claims of the present application.

Independent claims 25, 34, 42, 48 55 and 62 each recite subject matter pertaining to a weighted second node corresponding to a first node of the ontology, each weighted second node indicating the degree to which the user is interested in the concept of the corresponding first node of the ontology.

The Office Action correctly notes that Papierniak fails to teach the claimed subject matter pertaining to weighted second nodes and it relies upon Smith for these teachings, which is not prior art to claims of the present application. Financialengines.com fails to overcome this deficiency of Papierniak nor was it relied upon to do so.

Accordingly, Applicants respectfully submit that independent claims 25, 34, 42, 48, 55 and 62, as well as claims 2-4, 6-17, 20-24, 26-30, 32, 33, 35-39, 43-46, 49-51, 53-55, 56, 60, 61 and 63-67 depending therefrom, are allowable over the cited prior art.

Conclusion

Based on the foregoing, Applicants respectfully submit that the application is in condition for allowance and a Notice to that effect is earnestly solicited. Should the Examiner believe that anything further is desirable in order to place the application in even better form for allowance, the Examiner is respectfully urged to contact Applicants' undersigned representative at the below-listed number.

Respectfully submitted,

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